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March 19, 2007
Date of Signature

PATENT
Case No.: AUS920000812US1
(9000/12)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re patent application of:	)	
	)	
STEVEN M. FRENCH, ET AL.	)	Examiner: NGUYEN, THANH
	)	
Serial No.: 09/731,629	)	
	)	Group Art Unit: 2144
Filed: DECEMBER 7, 2000	)	
Title: METHOD AND SYSTEM FOR AUTOMATICALLY ASSOCIATING AN ADDRESS WITH A TARGET DEVICE	)	Conf. No.: 1076

APPEAL BRIEF

Mail Stop Appeal Briefs - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants herewith respectfully present their appeal brief as follows:

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1. REAL PARTY IN INTEREST

The real party in interest remains Assignee INTERNATIONAL BUSINESS MACHINES CORPORATION, by virtue of an assignment executed by the inventors on December 5, 2000 and filed with the United States Patent and Trademark Office on December 7, 2000, recorded at reel number 011372 frame number 0014.

2. RELATED APPEALS AND INTERFERENCES

Appellants and the undersigned attorneys are not aware of any appeals or any interferences which will directly affect or be directly affected by or having a bearing on the Board's decision in the pending appeal. Appellants do note that related cases 09/731,624 and 09/731,631 are currently pending. The '624 application is currently in limbo and Appellants have previously filed an appeal brief that remains unacknowledged by the PTO and a status request. The '631 application is on appeal before this Board. However, neither case will directly affect or be affected by or have a bearing on the Board's decision in this appeal.

3. STATUS OF CLAIMS

Claims 1-9, and 11-27 are pending. Claims 1, 13, and 23 stand rejected under 35 U.S.C. §112. Claims 1-9 and 11-27 stand rejected as unpatentable over Beelitz, et. al., United States Patent No. 6,182,275 B1 in view of Cohn et. al, United States Patent 6,411,684. Claim 10 was previously cancelled.

Claims 1-9 and 11-27 are the claims on appeal. *See*, Appendix.

4. STATUS OF AMENDMENTS

All amendments have been entered.

5. SUMMARY OF CLAIMED SUBJECT MATTER

In this summary of claimed subject matter, all citations are to the specification of United States Patent Application 09/731,629 filed on December 7, 2000. Further, all citations are illustrative only and support for the cited element may be found elsewhere in the specification.

Independent claim 1:

Independent claim 1 recites a method of generating a list of target devices to be configured in communication with a server. The method includes creating a first list of target devices to be configured 504 and identifying at least one addressed target device 408, 410, 412 having an associated network address. The method further includes modifying the first list of target devices using the addressed target device 510, and generating a modified list of target devices to be configured 544, wherein the target devices are to be remotely booted by the server 404 and wherein the target devices 408, 410, 412 are persistently and concurrently in communication with the server 404 by means of a network 402. *See*, FIGS 4 and 5, and pages 10-14 of the specification, *inter alia*.

Independent claim 13:

Independent claim 13 recites a computer readable medium including computer readable code. The medium includes means for creating a first list of target devices to be configured 504 and means for identifying at least one addressed target device 408, 410, 412 having an associated network address. The medium further includes means for modifying the first list of target devices using the addressed target device 510, and means for generating a modified list of target devices to be configured 544, wherein the target devices are to be remotely booted by the server 404 and wherein the target devices 408, 410, 412 are persistently and concurrently in communication with the server 404 by means of a network 402. *See*, FIGS 4 and 5, and pages 10-14 of the specification, *inter alia*.

Independent claim 23:

Independent claim 23 recites a data processing system including target devices and a server. The data processing system includes means for creating a first list of target devices to be configured 504 and means for identifying at least one addressed target device 408, 410, 412 having an associated network address. The medium further includes means for modifying the first list of target devices using the addressed target device 510, and means for generating a modified list of target devices to be configured 544, wherein the target devices are to be remotely booted by the server 404 and wherein the target devices 408, 410, 412 are persistently and concurrently in communication with the server 404 by means of a network 402. *See*, FIGS 4 and 5, and pages 10-14 of the specification, *inter alia.*

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1, 13, and 23 were rejected under 35 U.S.C. §112/1 as failing to comply with the written description requirement.

Claims 1-9 and 11-27 were rejected as unpatentable over Beelitz, et. al., United States Patent No. 6,182,275B1 in view of Cohn et. al, United States Patent 6,411,684.

7. ARGUMENTS

A. Claims 1, 13, and 23 were rejected under §112 ¶1 as failing to comply with the enablement requirement.

The §112 ¶1 rejection of claims 1, 13, and 23 is traversed. Appellants note that the Examiner reopened prosecution after the previous appeal, apparently solely to present this §112 rejection, and failed to address Appellants comments in the response filed June 20, 2006, and instead focused solely on the previous arguments.

The enablement requirement refers to the requirement of 35 U.S.C. 112, first paragraph that the specification describe how to make and how to use the invention. The invention that one skilled in the art must be enabled to make and use is that defined by the claim(s) of the particular application or patent. See, MPEP §2164.

The enablement requirement of 35 U.S.C. 112, first paragraph, is separate and distinct from the description requirement. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) ("the purpose of the 'written description' requirement is broader than to merely explain how to 'make and use'"). See also MPEP § 2161. Therefore, the fact that an additional limitation to a claim may lack descriptive support in the disclosure as originally filed does not necessarily mean that the limitation is also not enabled. In other words, the statement of a new limitation in and of itself may enable one skilled in the art to make and use the claim containing that limitation even though that limitation may not be described in the original disclosure. Consequently, such limitations must be analyzed for both enablement and description using their separate and distinct criteria. See, MPEP §2164.

Here, the Examiner appears to argue that one of ordinary skill in the art cannot practice the invention without undue experimentation based on the recitation in the preamble that the target devices are persistently and concurrently in communication with the server by means of a network. This assertion is made without any evidence, and without even stating a prima facie case of lack of enablement.

First, a prima facie case of lack of enablement is premised on those of ordinary skill in the art, and whether such a person would find that the experimentation needed to practice the invention undue or unreasonable. Any analysis of whether a particular

claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even though the statute does not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). See also *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) ("The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation."). A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987); and Linde*mann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984). Determining enablement is a question of law based on underlying factual findings. *In re Vaeck*, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991); *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1576, 224 USPQ 409, 413 (Fed. Cir. 1984).

Here, the Examiner fails to even *allege* that undue experimentation is necessary. Enablement under §112 ¶1 is concerned with the level of experimentation that would be required by one of ordinary skill in the art. Here, the level of experimentation required is minimal, as those of skill in the networking arts are well familiar with target devices [that] are persistently and concurrently in communication with [a] server by means of a network. Should the Examiner intend to seriously contend that those of skill in the networking arts do not understand this limitation or would require undue experimentation

to understand this limitation, Appellants gently demand that the Examiner provide evidence of the level of skill in the art.

Withdrawal of the rejection to claims 1, 13, and 23 is requested.

B. The Examiner rejected claims 1-9 and 11-27 as unpatentable under 35 U.S.C. §103(a) by Beelitz in view of Cohn

Appellants note that this rejection was the subject of a previous appeal to this Board, and that the Examiner has reasserted the same rejection after reopening prosecution.

The §103(a) rejection of claims 1-9 and 11-27 has been traversed. In order to maintain this §103(a) rejection, each and every element of the claimed invention must be taught or suggested by the references alone or in combination. Because the references do not teach or suggest each and every element, this rejection must fall.

Claims 1, 13, and 23 require, *inter alia*, "the target devices are persistently and concurrently in communication with the server by means of a network." The Examiner correctly notes that Beelitz does not teach or suggest such an element, and instead cites to Cohn for such teachings. Specifically, the Examiner asserts that it "would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the teachings of Cohn into the computer system of Beelitz to have persistent and concurrent in communication with the server by means of a network because it would have been provided specific functions that can operating or occurring at the same time and continuing without change in function or structure in the network." [sic] See, ¶5 of the September 20, 2005 office action.

The Appellants traverse the Examiner's assertion because Beelitz specifically teaches away from such a combination, there must be a reasonable expectation of success, and the mere ability to combine references is insufficient to support a rejection.

Beelitz teaches away from the combination

Beelitz teaches a generation of a compatible order for a computer system. The Beelitz system is for specifying, ordering, and building a build-to-order computer system, such that a purchaser of a build-to-order computer system can buy and order such a computer over a computer network such as the Internet. See, abstract, Beelitz.

Beelitz, teaches "[I]n step 207, control 103 *provides to the user interface 105* a list of the operating system types available." (emphasis added) at column 7 55-56. Furthermore,"[I]n step 204, *control 103 accesses the master data base 125* to create or generate a list of operating system types available for the targeted computer system" (column 7 lines 35-37).

Control 103 "receives an indication *from a user interface* 105 indicating the desire to purchase a computer system." Column 7, lines 30-32 (emphasis added). Thus, control 103 is distinguished from the targeted computer system 137 (FIG. 1 of Beelitz) and the terminal or user interface 105 (FIG. 1 of Beelitz).

Beelitz teaches that it has been known to install software programs and to perform tests on computer systems *before they are shipped* to businesses or individual customers. The goal of software installation and testing, according to Beelitz, is to efficiently produce a useful, reliable, computer system which may be *delivered* to businesses and individuals free from errors and ready to run. Beelitz, column 1, lines 56-61.

One of ordinary skill in the art would recognize that shipping a computer to a business or individual customer requires *disconnecting* any network connections used for software installation and testing. Those of ordinary skill in the art would also recognize that disconnecting a network connection terminates the connection, and therefore disconnecting a network connection is inconsistent with a persistent and concurrent network connection. Thus, one of ordinary skill in the art could not possibly be motivated to make the modifications suggested by the Examiner, as Beelitz unequivocally teaches away from the combination.

At most, Beelitz discloses that a targeted computer system 137 is initially booted up to perform the operations and instructions as per associated shell script files to load the selected programs onto its hard drive and to run the tests. In one embodiment, the selected software programs and operating systems can be down loaded and installed on

the targeted computer system via the Internet. *See*, column 15, lines 1-7. Thus, Beelitz does not disclose "the target devices are persistently and concurrently in communication with the server by means of a network." Beelitz teaches only loading and installing the operating system onto the targeted computer system, prior to disconnecting the network connection to enable the newly built-to-order computer to ship to a business or individual.

There is no reasonable expectation of success

Similarly, there is no reasonable expectation of success based on the combination of references. MPEP 2143.02, In re Merck & Co., 800 F.2d 1091 (Fed. Cir. 1986). Here, modifying the Beelitz system to feature "target devices [that] are persistently and concurrently in communication with the server by means of a network" would entirely defeat the purpose of Beelitz, and cannot lead to any reasonable expectation of success. Indeed, one of ordinary skill in the art would more likely find a reasonable expectation of *failure*.

The Examiner asserts that it "would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the teachings of Cohn into the computer system of Beelitz to have persistent and concurrent in communication with the server by means of a network because it would have been provided specific functions that can operating or occurring at the same time and continuing without change in function or structure in the network." [sic] However, any such modification would in fact change the function or structure of the network, contrary to the Examiner's assertions. The function and structure of the Beelitz network is to efficiently produce a useful, reliable, computer system which may be *delivered* to businesses and individuals free from errors and ready to run. Beelitz, column 1, lines 56-61. Modifying the function or structure of the Beelitz network would not result in the claimed invention, but would rather result in a business or individual purchasing a built-to-order computer that is not delivered to the purchasing business or individual, but rather a computer that remains at the factory, sitting on an assembly line.

The mere ability to combine references is insufficient to support a rejection

The mere fact that Beelitz can be modified in view of Cohn to obtain the claimed invention (which Appellants deny) does not render the resultant modification obvious unless the prior art also suggests the desirability of the combination. See, *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Claims were directed to an apparatus for producing an aerated cementitious composition by drawing air into the cementitious composition by driving the output pump at a capacity greater than the feed rate. The prior art reference taught that the feed means can be run at a variable speed, however the court found that this does not require that the output pump be run at the claimed speed so that air is drawn into the mixing chamber and is entrained in the ingredients during operation. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).

The basis for the Examiner's assertion is that "it would have been provided specific functions that can operating or occurring at the same time and continuing without change in function or structure in the network." (pg. 3, Sept. 20, 2005 office action). However, the Examiner simply cannot conclusively assert that an implementation of the allegedly persistent and concurrent communication with the server by means of a network taught by Cohn would permit the ability to efficiently produce a useful, reliable, computer system which may be *delivered* to businesses and individuals free from errors and ready to run. *See*, Beelitz, column 1, lines 56-61. Indeed, implementing a persistent and concurrent communication with a server, as allegedly taught by Cohn, would simply not work in a Beelitz system and would destroy the principle of operation of Beelitz.

Therefore, Appellants request the withdrawal of the rejections to claims 1, 13, and 23, as well as claims 2-9, 11-12, 14-22 and 24-27 depending directly or indirectly from one of claims 1, 13, or 23.

SUMMARY

The Appellants respectfully request maintenance of their appeal, and submit that claims 1-9 and 11-27 fully satisfy the requirements of 35 U.S.C. §§102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

Dated: **March 19, 2007**

Respectfully submitted,
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10. APPENDIX

1. A method of generating a list of target devices to be configured in communication with a server comprising:

creating a first list of target devices to be configured;

identifying at least one addressed target device having an associated network address;

modifying the first list of target devices using the addressed target device; and

generating a modified list of target devices to be configured, wherein the target devices are to be remotely booted by the server and wherein the target devices are persistently and concurrently in communication with the server by means of a network.

2. The method of claim 1 wherein the addressed target device is listed in at least one information source.

3. The method of claim 1 further comprising:

adding the associated network address of the addressed target device to the first list of target devices.

4. The method of claim 1 further comprising:

adding the addressed target device having an associated network address to the first list of target devices.

5. The method of claim 1 further comprising:

removing the addressed target device having an associated network address from the first list of target devices.

6. The method of claim 1 further comprising:

pre-configuring at least one preconfigured target device.

7. The method of claim 6 further comprising:

adding the preconfigured target device to the first list.

8. The method of claim 1 further comprising:

determining if a target device has an associated network address; and

removing the target device from the modified list of target devices if it does not have an associated network address.

9. The method of claim 1 further comprising:

providing the modified list to the server.

11. The method of claim 1 further comprising:

examining packet data to determine if a target device has an associated network address.

12. The method of claim 1 further comprising:

examining log data to determine if a target device has an associated network address.

13. A computer readable medium including computer readable code for generating a list of target devices to be configured in communication with a server comprising:

means for creating a first list of target devices to be configured;

means for identifying with an identification at least one addressed target device having an associated network address;

means for modifying the first list of target devices using the addressed target device; and

means for generating a modified list of target devices to be configured, wherein the target devices are to be remotely booted by the server and wherein the target devices are persistently and concurrently in communication with the server by means of a network.

14. The medium of claim 13 further comprising:

means for storing the identification of the addressed target device.

15. The medium of claim 13 further comprising:

means for adding the associated network address of the addressed target device to the first list of target devices.

16. The medium of claim 13 further comprising:

means for adding the addressed target device having an associated network address to the first list of target devices.

17. The medium of claim 13 further comprising:

means for removing the addressed target device having an associated network address from the first list of target devices.

18. The medium of claim 13 further comprising:

means for preconfiguring at least one target device listed in the first list.

19. The medium of claim 13 further comprising:

means for removing a target device without an associated network address from the modified list of target devices.

20. The medium of claim 13 further comprising:

means for configuring the target devices listed in the modified list.

21. The medium of claim 13 further comprising:

means for examining packet data to determine if a target device has an associated network address.

22. The medium of claim 13 further comprising:

means for examining log data to determine if a target device has an associated network address.

23. A data processing system, the system including target devices and a server comprising:

means for creating a first list of target devices to be configured, wherein the target devices are to be remotely booted by the server;

means for identifying at least one addressed target device having an associated network address;

means for comparing the addressed target device to the target devices on the first list; and

means for generating a modified list of target devices to be configured based on the addressed target device and wherein the target devices are persistently and concurrently in communication with the server by means of a network.

24. The system of claim 23, further comprising:

means for storing information about the addressed target device.

25. The system of claim 23 further comprising:

means for configuring at least one target device.

26. The system of claim 23 further comprising:

means for determining if a target device has an associated network address.

27. The method of claim 1 further comprising:

creating a router list of target devices;

comparing the router list and the first list of target devices, and wherein

modifying the first list of target devices using the addressed target device comprises modifying the first list of target devices based on the comparison.

Evidence Appendix

None

Related Proceedings Appendix

None.